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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/780,279 | 02/09/2001 | A. Buell Ish III | 500783.01 | 8038 |

7590 11/21/2003
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EXAMINER

MATHEW, FENN C

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3764

DATE MAILED: 11/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/780,279

Applicant(s)

ISH, A. BUELL

Examin r

Fenn C Mathew

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-9, 12-23 and 36-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-9, 12-23 and 36-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 28, 2003 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 2-3, 5-9, 12-13, 15, 18-21, 36-38, and 40 rejected under 35 U.S.C. 102(b) as being anticipated by Kuervers (U.S. 4,938,477). Referring to claim 6, Kuervers discloses in column 3, lines 21-28, a pad assembly comprising a compressible layer (25) having a first surface adapted to engage a portion of a user's body, and a second surface opposite from the first surface, and an elongated plate member (26) of approximately uniform thickness (see figs. 5-6) having front and back surfaces, the front surface being engaged with the second surface of the compressible layer, and wherein the front surface of the elongated plate member is shaped to provide an approximately

uniform-thickness portion of the compressible layer when a compression force is applied to the first surface during an exercise.

4. Referring to claim 2, Kuervers discloses the elongated plate backing member comprising a contoured support attached to the second surface.

5. Referring to claim 3, Kuervers discloses the front surface comprising a contoured portion that provided a compressed shape of the compressible layer that approximately corresponds with an anticipated shape of the portion of the user's body.

6. Referring to claim 5, Kuervers discloses the first surface comprising a concave portion adapted to engage a portion of the user's body.

7. Referring to claim 7, Kuervers discloses a device wherein the approximately uniform-thickness portion is co-extensive with a portion of the first surface adapted to engage the portion of the user's body.

8. Referring to claim 8, Kuervers discloses the front surface of the elongated plate member is shaped to provide an approximately uniform pressure portion when a compression force is applied to the first surface during exercise.

9. Referring to claim 9, Kuervers discloses the device further comprising a coupling assembly (28, 29) coupled to the back surface of the elongated plate member and being adapted to attach to an exercise device.

10. Referring to claim 12, Kurevers discloses a device including a backing plate of approximately uniform thickness having front and back surfaces and being elongated in a first direction along a first axis, the backing plate being contoured such that the first axis forms a curve, and a compressible member having a first surface adapted to

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engage a portion of a user's body and a second surface opposite from the first surface, the second surface being coupled to the front surface of the backing plate such that a compression force applied to the first surface provides an approximately uniform-thickness portion of the compressible member between the first surface and the backing plate.

11. Referring to claim 13, Kuervers discloses the second surface of the compressible member comprises a depressed portion adapted to fittingly engage at least a portion of the backing plate.

12. Referring to claim 15, Kuervers discloses the approximately uniform-thickness portion is co-extensive with a portion of the first surface adapted to contact the portion of the user's body.

13. Referring to claim 18, Kuervers discloses the compressible member providing a first surface approximately corresponding with an anticipated shape of the portion of the user's body when a compressible force is applied.

14. Referring to claim 19, Kuervers discloses a pad assembly comprising a layer of compressible padding (25) having a first surface adapted to engage a portion of a user's body and a second surface opposite from the first surface; and a backing structure (26) attached to the layer of compressible padding and having an approximately uniform-thickness, the backing structure including a backing surface proximate the second surface and being shaped to provide an approximately uniform-thickness portion of the layer of compressible padding when a compression force is applied to the first surface.

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15. Referring to claim 20, Kuervers discloses the backing structure is contoured such that the compression force is approximately uniformly distributed over the first surface.

16. Referring to claim 21, Kuervers discloses the approximately uniform-thickness portion is co-extensive with the first surface.

17. Referring to claim 36, Kuervers discloses a method including providing a compressible layer having a first surface, and a backing structure having an approximately uniform-thickness and including a non-planar backing surface engaged against the compressible layer opposite the first surface, and pressing a portion of a user's body against the first surface to compress the compressible layer between the portion of the user's body and the non-planar backing surface and to form an approximately uniform-thickness portion of the compressible layer therebetween.

18. Referring to claim 37, Kuervers discloses pressing a portion of a user's body against the first surface to compress the compressible layer comprises pressing a portion of a user's body against the first surface to form an approximately uniform-thickness portion of the compressible layer that is co-extensive with the portion of the user's body.

19. Referring to claim 38, Kuervers discloses the method wherein pressing a portion of a user's body against the first surface to compress the compressible layer comprises pressing a portion of the user's body against the first surface to form an approximately uniform-pressure distribution on the portion of the user's body (inherently due to the shape of the backing structure).

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20. Referring to claim 40, Kuervers discloses the method wherein pressing a portion of a user's body against the first surface to compress the compressible layer comprises pressing a portion of a user's arm against the first surface.

21. Claims 36 and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Schiavone (U.S. 5,462,508). Referring to claim 36, Schiavone discloses a method comprising providing a compressible layer (40) having a first surface and a backing structure having an approximately uniform thickness and including a non-planar backing surface engaged against the compressible layer between the portion of the user's body and the non-planar backing surface and to form an approximately uniform thickness portion of the compressible layer there between.

22. Referring to claim 41, Schiavone discloses the method wherein pressing a portion of the user's body against the first surface to compress the compressible layer comprises pressing a portion of a user's shoulder against the first surface.

23. Claims 12, 14, 19, 23, 36, and 38, are rejected under 35 U.S.C. 102(b) as being anticipated by Evans (U.S. 5,120,052). Referring to claim 12, Evans discloses a pad assembly comprising a backing plate (24) of approximately uniform thickness having front and back surfaces and being elongated in a first direction along a first axis, the backing plate being contoured such that the first axis forms a curve, and a compressible member (26) having a first surface adapted to engage a portion of a user's body, and a second surface opposite from the first surface, the second surface being coupled to the front surface of the backing plate such that a compression force applied to the first

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surface provides an approximately uniform-thickness portion of the compressible member between the first surface and the backing plate.

24. Referring to claim 14, Evans discloses the pad assembly wherein the backing plate comprises a contoured pad support projecting from a moveable portion (22) of the exercise machine.

25. Referring to claim 19, Evans discloses a pad assembly comprising a layer of compressible padding (26) having a first surface adapted to engage a portion of a user's body a second surface opposite from the first surface, and a backing structure attached to the layer of compressible padding and having an approximately uniform-thickness, the backing structure including a backing surface proximate the second surface and being shaped to provide an approximately uniform-thickness portion of the layer of compressible padding when a compression force is applied to the first surface.

26. Referring to claim 23, Evans discloses the backing structure comprising a channel (30) attached to the backing structure opposite from the layer of compressible padding and adapted to attach to a support portion of an exercise machine.

27. Referring to claim 36, Evans discloses providing a compressible layer having a first surface, and a backing structure having an approximately uniform thickness and including a non-planar backing surface engaged against the compressible layer opposite the first surface, and pressing a portion of the user's body and the non-planar backing surface and to form an approximately uniform-thickness portion of the compressible layer there between.

28. Referring to claim 39, Evans discloses the method wherein pressing a portion of a user's body against the first surface to compress the compressible layer comprises pressing a portion of a user's arm against the first surface.

Claim Rejections - 35 USC § 103

29. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

30. Claims 4, 16-17, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuervers. Referring to claims 4, 16, and 22, Kuervers has disclosed above Kuervers discloses the claimed structure except for the specific radius of curvature range. The aforementioned feature is considered a matter of design choice, wherein no stated problem is solved, nor any unexpected result attained using the radius of curvature of the Kuervers device.

31. Referring to claim 17, Kuervers discloses the claimed invention except for the specified material. Kuervers discloses the use of foam pads in col. 3, lines 21-22, but does not specifically name polyurethane. The specific material used would have been obvious to one having ordinary skill in the art at the time of invention, as the skilled artisan would have chosen a material based on its suitability for the intended purpose.

Response to Arguments

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32. Applicant's arguments with respect to claims 2-9, 12-23, and 36-41 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fenn C Mathew whose telephone number is (703) 305-2846. The examiner can normally be reached on Monday - Friday 9:00am - 5:30pm.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



NICHOLAS D. LUCCHESI
SUPERVISORY PATENT EXAMINER
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November 12, 2003